

REMARKS

Claims 1, 3, 5-7, 9, 18-20, 22-24, 26 and 28-34 are pending in the application and were rejected in the Final Office Action mailed January 13, 2009. Applicant responds to the rejection of claims 1, 3, 5-7, 9, 18-20, 22-24, 26 and 28-34 as follows.

Response to Claim Rejections – 35 U.S.C. § 103

A. Response to rejection of claims 1,3, 5-7, 9, 18-20, 23, 26 and 28-33 under 35 U.S.C. § 103

Claims 1, 3, 5-7, 9, 18-20, 23, 26 and 28-33 are rejected under 35 U.S.C. §103 as being unpatentable over Gidumal, U.S. Patent No. 6,296,691 in view of Dodd, U.S. Patent No. 6,116,373. The claims are rejected on the basis that Gidumal teaches “a data storage device . . . and an airflow guide (FIGS. 2A and 2B, Item 11) that projects into the housing and comprises an elastic wall . . . but fails to disclose wherein the elastic wall is a non-permeable elastomeric damping material.” “On the other hand, Dodd teaches a non-permeable elastomeric material (Figs. 1 and 2, Item 30) being used as a damping material”. The Office Action fails to establish that the subject matter of claims 1, 3, 5-7, 9, 18-20, 23, 26 and 28-33 is obvious based upon the proposed combination of Gidumal and Dodd, as detailed in the following discussions.

I. The Office Action fails to establish that it would be obvious to use an elastomeric damping material for the wall of the filter element 11 as disclosed by Gidumal.

The rejection sets forth that “[it] would have been obvious to a person with ordinary skill in the art at the time the invention was made to employ the Dodd elastomeric material as the Gidumal elastic wall because it would damp the vibrations created by the air flow and the rotation of the discs providing a sound absorbing characteristic to the enclosure”. The Dodd reference relied on to reject the claims discloses an acoustic horn for loudspeakers. The horn includes side walls 12A, 12B, 14A, 14B that cooperatively form the horn body 10. As taught by

Dodd, the walls 12A, 12B, 14A, 14B or horn body 10 are formed of known metals or metal alloys, such as aluminum or an aluminum alloy. (Dodd, Co1. 3, lines 15-20). Although the walls in Dodd includes slots 24 filled with a vibration damping material 30, Dodd teaches that the walls 12A, 12B, 14A, 14B of the horn are formed of a metal or metal alloy material and not an elastomeric material.

The Gidumal reference is relied on for disclosure of a filter element 11. Filter element 11 of Gidumal includes a molded section 15 and a planar filter layer 18. The molded section 15 of the filter element 11 includes walls formed of a multiple layer structure including an inner filter layer 22, another filtration layer 24 and an outer protective layer 26. Filtration occurs as the air passes through the filtration layers to collect particulate. Thus, as understood by one of ordinary skill in the art, the walls of the Gidumal filter 11 are breathable to allow air flow for filtration. Declaration of Mo Xu, ¶ 3, filed October 22, 2008. It would not be obvious to modify the walls of the Gidumal filter element 11 in view of Dodd to employ an elastomeric material since an elastomeric material would inhibit air flow necessary for filtration. Declaration of Mo Xu, ¶¶ 3-4 filed October 22, 2008. As such, the proposed combination would render the teachings of the primary reference inoperable for the intended purposes, thereby obviating any argument for obviousness in the proposed combination. See MPEP § 2143.01 and *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984).

As stated above, the Office Action provides that it would be obvious to one of ordinary skill in the art in view of Dodd to form the walls of the molded filter 15 of Gidumal of an elastomeric material to damp vibration. Dodd teaches damping vibration in a structure having metal walls. Specifically, Dodd discloses filling slots in the walls of a horn with a vibration damping material 30. As disclosed, in Dodd the vibration damping material 30 can be a plastic material extrusion, molding or an appropriate elastomeric material. Gidumal teaches molded filter construction formed of filter layers capable of filtering particulate. As disclosed in Gidumal, the filter layers can be formed of polymer filter membranes, such as a polypropylene membrane. Neither Dodd nor Gidumal teach an elastomeric filter layer. Dodd teaches a plastic vibration damping material 30. As described in Gidumal, filter layers or walls are formed of a

polymer filter material or membrane, such as polypropylene. Applicant therefore submits that there is nothing in the proposed combination of references to teach or suggest anything beyond forming walls of Gidumal's filter element 11 from a polymer filter material.

II. The Office Action fails to establish that the selection of an elastomeric material for the filter element 11 is a matter of obvious design choice.

In the Office Action, claims 1, 3, 5-7, 9, 18-20, 23, 26 and 28-33 are rejected for the reason that "it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice". Page 3 of the Office Action. As acknowledged, for selection of a material to be obvious, the material must be suitable for the intended use. As disclosed in Gidumal, walls of filter 11 are formed of filtration layers, such as a polypropylene or polymeric membranes, which are permeable to air flow. As established by the Declaration of Mo Xu, ¶ 4, the elastomeric material of Dodd does not provide a breathable wall for filtration. Accordingly, the Office Action fails to establish that the claimed subject matter is an obvious design choice in view of Dodd.

III. The Office Action fails to consider what the combination of references as a whole suggest to one of ordinary skill in the art.

On page 5, ¶3 of the Office Action, the Examiner states that "the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." However, following this statement, the Office Action provides that Dodd teaches a non-permeable elastomeric material being used as a damping material, which as admitted does not provide a breathable wall. Office Action ¶ 3. One skilled in the art would recognize that the filter of Gidumal requires breathable walls for the purpose of filtration. Declaration of Mo Xu, ¶ 3. Rejection of the claims as set forth on page 3 of the Office Action based upon Dodd without reference to Gidumal is evidence that the Examiner completely ignores the teachings in Gidumal of a molded structure having breathable walls for filtration. The failure to consider the teachings of the Gidumal reference as a whole is evidence that the Examiner fails

to consider what the combination of references suggest as a whole to one of ordinary skill in the art.

IV. When properly construed based upon the Graham factors, the claimed subject matter is not obvious over the combination of Gidumal and Dodd.

Pursuant to the Supreme Court in *KSR*, obviousness requires a multiple step analysis as set forth in *Graham v. John Deere Co.* The multiple step analysis is as follows.

- (A) the scope and content of the prior art is determined.
- (B) the differences between the prior art and the claims in issue are ascertained.
- (C) The level of ordinary skill in the pertinent art is determined; and
- (D) Any evidence of secondary considerations is evaluated.

When properly construed, the prior art teaches a filter formed of breathable walls as taught by Gidumal. Dodd teaches an acoustic metal horn having slots with a vibration damping material 30 to damp vibration. The prior art does not teach an airflow guide enclosed in a housing formed of an elastomeric material as claimed. The prior art teaches a filter element 11 formed of a polymer membrane, for example, to provide breathable walls for filtration. It would be contrary to the teaching in Gidumal to use a non-breathable elastomeric material for the walls of the Gidumal filter element 11.

V. The Office Action fails to consider each of the claim limitations of claims 6, 20 and 30.

Claim 6 is dependent upon claim 1 and claim 20 is dependent upon claim 9. Claims 6 and 20 recite wherein the housing includes a base deck and a cover and the airflow guide is formed in place to the cover. When evaluating claims for obviousness, all of the claim limitations must be considered and given weight. MPEP § 2143.03. In the Office Action, claims 6 and 20 were rejected on the basis that it would have been an obvious design choice to form in place the airflow guide without consideration of wherein the housing includes a base deck and a cover and the airflow guide is formed in place to the cover. Gidumal does not teach a molded filter structure formed in place to a cover of a housing. The Office Action fails to establish a *prima facie* basis to reject claims 6 and 20.

Claim 30 recites wherein the housing includes a base deck and a cover and the air flow guide is formed directly to a filter support of a filtration unit and the cover. In the Office Action, claim 30 is rejected on the basis that it would have been an obvious design choice to form in place the airflow guide without consideration of wherein the housing includes a base deck and a cover and the airflow guide is formed directly to a filter support of a filtration unit and cover as claimed. Thus, the Office Action fails to establish a *prima facie* basis to reject claim 33.

VI. The Office Action fails to consider each of the claim limitations of claim 33

Claim 33 recites wherein the elastomeric body includes a curvilinear body portion and spaced leg portions extending outwardly from the curvilinear body portion. Claim 33 was rejected on that basis that Gidumal teaches an airflow guide and Dodd teaches a non-permeable elastomeric material without consideration of the shape of the elastomeric body as a curvilinear body portion having spaced leg portions extending outwardly from the curvilinear body portion as claimed. Thus, the Office Action fails to establish a *prima facie* basis to reject claim 33.

B. Response to rejection of claims 22, 24, and 34 under 35 U.S.C. § 103

Claims 22, 24 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gidumal in view of Dodd and further in view of Izumi et al., U.S. Patent No. 6,008,965. Claim 22 is dependent upon claim 9 and further includes a filtration unit including a first filter support and a second filter support and the air flow guide is formed of an elastomeric body formed to the first filter support. As acknowledged on pages 3-4 of the Office Action, Gidumal and Dodd fail to teach a first filter support adjacent the airflow guide and a second filter support spaced from the first filter support to support a filter between two supports as claimed.

The Office Action provides however that Izumi discloses a filter unit that includes a support member 39 including a first filter support or rectification wall 32 being an airflow guide. Regardless of whether the rectification wall 32 of Izumi is a filter support and airflow guide, Izumi discloses that the rectification wall 32 and support member 39 are formed of a synthetic resin material and not an elastomeric material. Izumi does not teach wherein the airflow

guide comprises an elastomeric body formed to the filter support member or rectification wall 32 as claimed.

The Office Action states that it would have been obvious to a person with ordinary skill in the art at the time the invention was made to employ the Izumi configuration with Gidumal and Dodd because it would provide the versatility of having an airflow guiding system and a filtration unit in a same unit. Gidumal discloses a molded filter for removing contaminants from an enclosure. On page 2 of the Office Action, the Examiner states that the filter element 11 of Gidumal is an airflow guide. Thus, based upon the Examiner's own characterization, Gidumal is an airflow guiding system and filtration unit in the same unit and thus there is no reason to modify Gidumal to provide an airflow guiding system and filtration unit based upon Izumi since item 11 of Gidumal is an air flow guiding system and filtration unit based upon the Examiner's characterization. In the event that the Examiner were to take the position that Gidumal does not teach an airflow guiding system, Applicant respectfully requests withdrawal of the rejection of claims 1, 3, 5-7, 9, 18-20, 23, 26 and 28-33 based upon the combination of Gidumal and Dodd. Based upon the foregoing, Applicant respectfully requests withdrawal of the rejection of claims 22, 24 and 34 for the reasons discussed above.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: /Deirdre Megley Kvale/
Deirdre Megley Kvale, Reg. No. 35,612
900 Second Avenue South, Suite 1400
Minneapolis, Minnesota 55402-3319
Phone: (612) 334-3222 Fax: (612) 334-3312

DMK:rev